

**REMARKS**

Reconsideration and withdrawal of the rejections set forth in the Office Action dated October 20, 2004, are respectfully requested.

The attorneys for the applicant wish to thank the Examiner for the thorough Office Action, including the specific citations to portions of the applied references and the elements of the claims to which those portions relate.

**Response to Holding Reply of July 7, 2004 as Not Fully Responsive**

The Examiner holds the reply of July 7, 2004 to be not fully responsive to the prior office action because the objection to claim 12 was not addressed. The Examiner then asserts that since the time period for reply to the previous office action has expired, the application will become abandoned unless the applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

The objection to claim 12 is addressed further herein and applicant believes the claim overcomes the objection.

Applicant believes the July 7, 2004 reply to be a *bona fide* attempt to advance the application to final action. According to MPEP 714.03:

Where an amendment substantially responds to the rejections, objections, or requirements in a non-final Office action but contains a minor deficiency (e.g. fails to treat every rejection, objection, or requirement), the examiner may simply reiterate the rejection, objection, or requirement not addressed by the amendment.

The reply of July 7, 2004 substantially addresses all of the April 7, 2004 objections and rejections, including amending claims and replying to the Rejections under 35 U.S.C. 102 and 35 U.S.C. 103. Furthermore, the omission of addressing the objection to claim 12 did not hinder the advancement of the application to final action, and should not be considered

a "serious omission," as the Examiner, in the last Office action, was able to apply new grounds of rejection to the claim.

In addition, applicant believes that a petition under 37 CFR 1.136(a) and corresponding fee are not necessary since the Examiner did not issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). According to MPEP 714.03, if there is insufficient time remaining for reply to the non-final Office action (or within any extension under 1.136(a)), the Examiner should issue an Office action setting a 1-month time period to complete the reply.

The Office action was mailed on April 7, 2004. Applicant's response was filed on July 7, 2004. The next Office action, indicating the applicant's July 7, 2004 response to be not fully responsive, was mailed on October 20, 2004, over six months after the April 7, 2004 Office action. Therefore, the first indication of a not fully responsive reply was outside the statutory 6-month period for reply, and the Examiner should have issued an Office action setting a 1-month time period to complete the reply.

Therefore, applicant respectfully requests the Examiner to withdraw the holding of the July 7, 2004 reply as being not fully responsive and allow the applicant simply to amend claim 12 as above in order to overcome the objection.

#### **Disclosed Embodiments of the Invention**

Embodiments of the invention are directed to a system that receives telephone calls or other continuous information streams, where these streams include spoken address information. The spoken address information can include various electronic addresses embedded therein, such as telephone numbers, email addresses, Uniform Resource Identifiers (URI), and so forth. Thus, as opposed to existing "voice dial" systems, whereby a user of a mobile phone may enter a special mode and audibly voice commands including phone numbers, embodiments of the invention monitor an ongoing voice stream (live or

recorded) as a background process to identify electronic addresses. Once activated, the process monitors the incoming voice streams to identify electronic addresses and extract or convert these addresses into a format so that they may be used automatically. For example, in one embodiment the voice recognition system scans or evaluates a voicemail message and identifies portions of the message possibly containing address information. Application at [0045]. The identified address information may then be extracted and formatted, e.g., converted from speech to text or otherwise converted into an alphanumeric string, and made available to a user of a portable communication device, who may then provide user input (e.g., to press the " \* " button) to quickly connect to some external device associated with that electronic address.

Under another embodiment of the invention, the system employs pattern recognition and parses through a live or recorded audio stream for select spoken phrases, such as "my number is," "call me at," "leave me a message at," "my email address is," as well as other voice patterns described in the application, such as at [0052]. Thus, this embodiment of the invention may improve the background scanning of voice streams to identify spoken phrases indicating existence of a spoken electronic address.

Since embodiments of the invention provide for automatic identification of voiced address information, there is no need for user input (such as the pressing of a record button) before the system extracts and converts the addresses.

### **The Applied Art**

U.S. Patent Application Publication 2003/0190020 to Kitchings is directed to a telephone system where, upon user activation of a recording feature, a phone number may be stored in a phone during a conversation. In Kitchings, a user 202 has a conversation with a friend 201. The friend wants to give the user a phone number. The user then presses a record button 204 to begin a recording mechanism. The phone records the phone number spoken by the friend. The user presses the record button a second time to

stop the recording mechanism. The user then may press another button to store the recorded number into the memory of the phone. [Paragraph 0017] Therefore, the system of Kitchings provides a recorded phone number to the user, which the user, if so desired, will identify and store via user inputs.

U.S. Patent No. 5,652,789 to Miner et al. is directed to a network based knowledge assistant that recognizes speech and performs functions within the familiar office model. The system of Miner et al. employs a traditional voice interface like a "voice dial" system, whereby users can dial phone numbers and perform other actions using the voice interface. For example, users can create new contacts by copying them from an electronic phone book. A subscriber must add a voice identification to a phone book entry that is to be added to a contact list so that the new contact may be identified via the voice interface. See e.g., column 39, lines 43-47. A contact can also be created when receiving a message (where a "contact" is analogous to an entry in an address book file, while a "message" is commonly a voice mail message). Column 39, lines 48-54; column 5, lines 58-62, and column 6, lines 10-12. In particular, a subscriber can say "yes" in response to the assistant asking if the subscriber wishes to transfer the contact out of the message and into the subscriber's contact list. As a result, the user again must add voice identification. Id.

U.S. Patent Application No. 2004/0062365 to Agraharam et al. discloses a voice messaging system for converting oral messages into text. Agraharam et al. allows a calling party to send an electronic mail message by first soliciting the caller to provide information in order to compose and transmit the email message. Paragraph [0013]. After soliciting the caller to provide an email address, the email address may be obtained by either having the calling party speak the email address, enter the email address using the telephone's keypad, or speaking the recipient's name and looking up the recipient's email address in a database. Paragraphs [0014] and [0015]. In either case, Agraharam et al. specifically requires the system to actively solicit the user for either spoken or keypad input. Thus, as with Miner et al. and Kitchings, the system of Agraharam et al. employs a

special, active mode for processing a spoken message that engages a caller via a voice interface or audible menu of choices.

US Patent Number 6,553,024 to Hunlich et al. describes a method of providing performance features at external terminals of a communication system. When an external terminal signs on to a communications system, a voice link is set up between the terminal and a teleworking subscriber line module within the system. Control information is transferred to the terminal via DTMF signals.

### **Claim Objections**

Claim 12 is objected to as being indefinite for being unclear as to whether the limitations after the phrase "during normal reception" are part of the claimed invention. Applicants respectfully state that all the limitations in the claim are intended and therefore part of the claimed invention. The phrase "during normal reception and not under a special mode" which the Examiner has questioned, is an intended element reciting the "recognizing" and "extracting" functions to be during a normal reception of voice streams.

### **Rejections under 35 U.S.C. § 102**

Claims 1, 8, 11 and 21 are rejected under 35 U.S.C 102(e) as being anticipated by Kitchings (US 2003/0190020).

Claims 1 and 21 have been amended to recite the element of identifying voiced address information occurring automatically and without the need for a user to activate a voice record function. In contrast, Kitchings specifically teaches a system where the identifying of a phone number may occur only after a user presses a record button on a phone. As mentioned above, the system provides to a user a recorded version of a voiced phone number upon which the user can then identify and store via user inputs. It follows that Kitchings does not teach the automatic identifying of voiced address information, nor

the automatic identifying of voiced address information without the activating of a voice record function, and therefore does not recite all the elements set forth in the claimed invention. For at least these reasons, applicant believes claims 1 and 21 to be patentable over Kitchings.

### **Rejections under 35 U.S.C. § 103**

#### **The applied references, even if combined, fail to disclose the claimed invention**

Claims 2-5 and 10 are rejected under 35 U.S.C 103(a) as being unpatentable over Kitchings (US 2003/0190020) in view of Minor et al. (US 5,652,789).

As stated above, Kitchings does not disclose identifying voiced address information without activating a voice record function, as recited in claim 1. Since claims 2-5 and 10 depend on claim 1, applicant believes these claims are likewise patentable over Kitchings in view of Minor et al.

Claims 9, 12, 19 and 22 are rejected under 35 U.S.C 103(a) as being unpatentable over Kitchings (US 2003/0190020) in view of Agraharam et al. (US 2004/0062365).

As stated above, Kitchings does not disclose identifying voiced address information without activating a voice record function, as recited in claim 1. Since claim 9 depends on claim 1, applicant believes claim 9 is likewise patentable over Kitchings in view of Agraharam *et al.*

Claims 12, 19 and 22 have been amended to recite the element of identifying voiced address information occurring automatically and without the need for a user to activate a voice record function. In contrast, Kitchings specifically teaches a system to capture a phone number only after a user presses a record button on a phone. Paragraph [0017]. Agraharam et al. is directed to a system which actively solicits a user for address information such as an email address, and then converts the information into text. Neither

Kitchings nor Agraharam et al., alone or in combination, teach the element of automatically identifying voiced address information without additional user input, and for at least this reason, applicant believes claims 12, 19 and 22 to be patentable over Kitchings in view of Agraharam et al.

Claims 13-14 and 16-17 are rejected under 35 U.S.C 103(a) as being unpatentable over Miner et al. (US 5,652,789) in view of Kitchings (US 2003/0190020).

Claims 13 and 16 have been amended to recite the element of identifying spoken address information occurring automatically, and without the need for a user to activate a voice record function. As stated above, Miner et al. teaches a network based knowledge assistant which recognizes voiced information. A user may access information based on voiced command, but only after the information is selected by the user as being a voice entry. Kitchings, described earlier, records and stores phone numbers during conversations, but does so only after the user presses a record button to start and stop the recording. Thus, neither Miner et al. nor Kitchings, either alone or in combination, recite the element of automatically identifying spoken address information without activating a voice record function. For at least this reason, applicant believes claims 13 and 16, and dependent claims 14 and 17, to be patentable over Miner et al. in view of Kitchings.

Claims 15 and 18 are rejected under 35 U.S.C 103(a) as being unpatentable over Miner et al. (US 5,652,789) in view of Kitchings (US 2003/0190020) and further in view of Hunlich et al. (US 6,553,024).

Hunlich et al. is directed to a method of providing performance features to mobile subscribers via a communications network. There is no teaching of identifying voiced information, and especially no teaching of identifying voiced information without activating a voice record function.

Therefore, the combination of Miner in view of Kitchings and further in view of Hunlich does not recite all the elements of claims 15 and 18, and for at least this reason, claims 15 and 18 are patentable over the combination.

Claim 20 is rejected under 35 U.S.C 103(a) as being unpatentable over Kitchings (US 2003/0190020) in view of Agraharam et al. (US 2004/0062365) and further in view of Hunlich et al. (US 6,553,024).

As shown above, neither Kitchings nor Agraharam nor Hunlich provide a portable electronic device that automatically couples electronic addresses received in spoken communications where the address information is automatically identified and is identified without the activation of a voice record function.

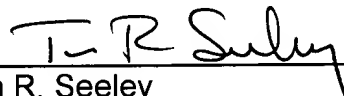
### **Conclusion**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 101948002US from which the undersigned is authorized to draw.

Dated: December 7, 2004

Respectfully submitted,

By   
Tim R. Seeley  
Registration No.: 53,575  
PERKINS COIE LLP/CW  
P.O. Box 1247  
Seattle, Washington 98111-1247  
(206) 359-8000  
(206) 359-7198 (Fax)  
Attorney for Applicant